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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,264	12/31/2003	Ian Legate	1865-US	8491
61574 7590 04/16/2009 LAW OFFICE OF BRUCE D. RUBENSTEIN 405 WALTHAM STREET, #404 LEXINGTON, MA 02421				
EXAMINER				
TO, TUAN C				
ART UNIT		PAPER NUMBER		
3663				
MAIL DATE		DELIVERY MODE		
04/16/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/749,264

Applicant(s)

LEGATE ET AL.

Examiner

TUAN C. TO

Art Unit

3663

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 9-15 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 9-15 and 24 is/are allowed.
- 6) ☒ Claim(s) 18-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-20, 22, and 23 are rejected under 35 U.S.C. 112 (second paragraph) as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 18-20, 22, and 23 each recites "a local data acquisition unit" in claim 21. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mocek (US 20030182577A1) and in view of Rother (US 20030195681A1).

Mocek discloses a system and method for testing telematics software comprising:

A computer installed within a vehicle (figure 1, the TCU 102 is installed with the vehicle 100);

A telematics application, loaded on the computer and written using generic requests that are not particular to any make or model of vehicle (see paragraph 0050);

An electronic interface, operatively coupled to the computer, for connecting to a proprietary data bus of the vehicle (see paragraph 0041);

And an abstract software layer, loaded on the computer and operatively disposed between the telematics application and the electronic interface (see paragraph 0040).

The statements of intended use or field of use "for connecting...", "for storing...", "for retrieving...", "for extracting...", "for providing...", "for accessing...", "for enabling..." clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re

Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647 (Bd. Pat. App. & Inter. 1987).

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Mocek fails to disclose a database for storing vehicle specific data bus configuration information for a plurality of makes and models of vehicles.

Rother teaches a telematics system including a database for storing vehicle specific data bus configuration information for a plurality of makes and models of vehicles (paragraph 0055).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Mocek to include the database as taught of Rother for the purpose of storing a variety of diagnostics related data for several vehicle makes and models.

Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mocek (US 20030182577A1), Rother (US 20030195681A1), and further in view of Shultz et al. (US 7269482B1).

Mocek and Rother fail to disclose that the telematics application includes navigation application, security application, and diagnostic application.

The reference to Shultz et al. is provided as teaching an in-vehicle information system including the navigation application, the security application, and the diagnostic application (see column 3, lines 46-66).

Hence, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Mocek and Rother to include the various applications as taught by Shultz et al. in order to gain the advantage of increasing vehicle's user satisfaction of obtaining different vehicle data as desired.

Allowable Subject Matter

Claims 1-4, 9-15 are maintained allowable. Claim 24 is now set in a condition of allowance since none of the cited reference, individually or in combination, disclose "retrieving, by the abstract software layer and responsive to the generic requests for vehicle parameter data by the telematics application, vehicle data bus configuration information from a database that stores data bus configuration information for a plurality of different types of data buses the retrieved vehicle data bus configuration information being associated with the type of data bus used on the vehicle on which the telematics application is run; extracting vehicle parameter data from the vehicle data bus using the vehicle data bus configuration information retrieved from the database."

Response to Arguments

In response to the applicant's amendment filed on 01/12/2009, the examiner has found that claim 21-23 are rejected as being unpatentable over Mocek (US 20030182577A1) and in view of Rother (US 20030195681A1). Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mocek (US 20030182577A1), Rother (US 20030195681A1), and further in view of Shultz et al. (US 7269482B1).

As indicated in this office action, the statements of intended use or field of use "for connecting...", "for storing...", "for retrieving...", "for extracting...", "for providing...", "for accessing...", "for enabling..." clauses are essentially method limitations or statements of intended or desired use. Therefor, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. Mocek includes all necessary components to implement desired used of the telematics system such as the in-vehicle computer which is installed within a vehicle, a telematics application loaded on said computer, an electronic interface, software layer.

Mocek merely fails to disclose a database for storing vehicle specific data bus configuration information for a plurality of makes and models of vehicles.

Rother teaches a telematics system including a database for storing vehicle specific data bus configuration information for a plurality of makes and models of vehicles (paragraph 0055).

Hence, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Mocek to include the database as taught of Rother for the purpose of storing a variety of diagnostics related data for several vehicle makes and models.

Conclusions

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan C To whose telephone number is (571) 272-6985. The examiner can normally be reached on from 8:00AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Tuan C To/

Primary Examiner of Art Unit 3663/3600

April 13, 2009